

### **REMARKS**

Applicants have carefully reviewed the Final Office Action mailed on September 8, 2010, prior to preparing this response. Currently, claims 15 and 26-33 are pending in the application and have been rejected. With this response, claim 34 has been cancelled. Favorable consideration of the above amendments and following remarks is respectfully requested.

#### **Claim Rejections Under 35 U.S.C. §112**

Claim 34 stands rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. While not conceding the appropriateness of this rejection, claim 34 has been cancelled with this response, rendering the rejection moot.

#### **Claim Rejections Under 35 U.S.C. §§102/103**

The Final Office Action indicates that claim 15 is rejected under 35 U.S.C. §102(e) as being anticipated by Wu et al., U.S. Pat. App. Pub. No. 2004/0243156. Applicants respectfully traverse this rejection.

Furthermore, the Final Office Action indicates that claims 15, 26-33 are rejected under 35 U.S.C. §102(e) as being anticipated by or, in the alternative, under 35 U.S.C. §103(a) as obvious over Wu et al., U.S. Pat. App. Pub. No. 2004/0243156. Applicants respectfully traverse this rejection.

#### **Inappropriateness of Rejection Under the Provisions of 35 U.S.C. §102**

Claim 15, among other limitations, recites, “wherein the means for cutting and means for gripping are defined by a series of undulations on the cutting blade in the first fully inflated configuration.” In the Final Office Action, it was indicated that “Wu is silent regarding any undulations of the blades when the balloon is inflated.” See Final Office Action, at paragraph 7.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” M.P.E.P. §2131, quoting *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). The admission in the Final Office Action that Wu et al. does not teach undulations of the blades when the balloon is inflated evidences that the §102(e) rejection of the currently pending claims is inappropriate.

Furthermore, in responding the Applicant's previously presented remarks regarding the teachings of Kelly, U.S. Pat. App. Pub. No. 2005/0228343, it was stated in the Final Office Action that "One of ordinary skill in the art at the time of the invention would have found it obvious that a metallic cutting blade that is similar to knife would hold its structural configuration as the balloon transitions from an deflated to fully inflated configuration, thus maintaining the undulations in the fully inflated state." Final Office Action, at paragraph 8. While Applicants do not agree with this assertion, it appears that this argument presented in the Final Office Action is formulated under the provisions of 35 U.S.C. §103(a).

Applicants maintain that even though the blade disclosed by Wu et al. may be formed from metal, the blade does not necessarily possess the rigidity to ensure that the undulations of the blade would remain when the balloon is inflated. For example, as noted previously the cutting blades disclosed in Kelly may be able to bend and flex while mounted to the balloon. See Kelly, at paragraph 0022. Kelly, which teaches the cutting blades may be formed of any suitable material such as a metal, metal alloy, or polymer, does not distinguish between these materials or indicate metal materials would not permit the described bending or flexing of the cutting blade when mounted to the balloon, concluding that any disclosed material, including metal, would permit the disclosed bending or flexing of the cutting blade while mounted to the balloon. In consideration of the size of such a cutting blade (e.g., on the order of 0.006 inches wide) a metal material would not necessarily be sufficiently rigid to prevent bending or flexing of the cutting blade. Furthermore, the inclusion of the joining member 38 of Kelly does not negate such a conclusion. The blade itself would need to be able to bend and flex, as described, regardless of the presence of the joining member 38 since the presence of the joining member 38 would not make an otherwise rigid blade become flexible. As such, Applicants assert that maintaining the undulations of Wu's blade when the balloon is inflated is not an inherent property of Wu's blade.

As a result, Applicants assert that Wu et al. at least does not expressly, impliedly or inherently disclose the noted limitations of claim 15. Withdrawal of the §102(e) rejections of the claims is respectfully requested.

Response to Rejection if Made Under the Provisions of 35 U.S.C. §103

As noted in the Final Office Action, in the alternative claims 15, 26-33 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Wu et al., U.S. Pat. App. Pub. No. 2004/0243156. Applicants respectfully traverse this rejection. Wu et al., which has a filing date of May 29, 2003 and a publication date of December 2, 2004 is available as prior art to the current application, if at all, under §102(e). However, §103(c) applies in this instance to remove the reference as prior art against the current application under 35 U.S.C. §103(a). See M.P.E.P. §2136.01. **Both Wu et al. and the current application were subject to an obligation of assignment to the same person at the time the invention was made.** The Wu et al. assignment to SciMed Life Systems, Inc. can be found at Reel 014129, Frame 0534, which has changed its name to Boston Scientific SciMed, Inc. as evidenced at Reel 018505, Frame 0868. The assignment of the current application to SciMed Life Systems, Inc. can be found at Reel 015620, Frame 0197, with a subsequent change of name to Boston Scientific SciMed, Inc. recorded at Reel 018505, Frame 0868. Therefore, Wu et al. is disqualified as prior art in formulating the obviousness rejection under the provisions of §103(c). Withdrawal of the rejection is respectfully requested.

Conclusion

Reconsideration and further examination of the rejections are respectfully requested. It is respectfully submitted that all pending claims are now in condition for allowance. Issuance of a Notice of Allowance in due course is requested. If a telephone conference might be of assistance, please contact the undersigned attorney at (612) 677-9050.

Respectfully submitted,

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By their Attorney,

Date: Nov 8, 2010

  
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